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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/401,167 09/21/99 LEE

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EXAMINER

MM91/0509

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ART UNIT

PAPER NUMBER

2859

DATE MAILED:

05/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/401,167

Applicant(s)

Lee

Examiner

Gail Verbitsky

Group Art Unit

2859



☒ Responsive to communication(s) filed on Mar 5, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-16 is/are pending in the application

Of the above, claim(s) 11-16 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7(3pg)

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2859

DETAILED ACTION

Restriction by Original Presentation

1. Newly submitted claims 11-16 are directed to a method for forming a housing for a thermometer that is independent or distinct from the invention originally claimed for the following reasons:

A) the original claimed invention, i.e., claims 1-10, is directed to a thermometer.

B) the invention stated in claims 11-16 is directed to a method for forming a housing for a thermometer.

C) the invention originally claimed in claims 1-10 is classified in class 374, subclass 208.

D) the invention stated in new claims 11-16 is classified in class 29, subclass 590+.

Furthermore, the claimed thermometer can be manufactured by a method different from the method claimed by applicant such as, for example, a method which does not require providing a premold.

2. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for further prosecution on the merits. Accordingly, claims 11-16 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR and MPEP 821.03.

Art Unit: 2859

Claim Objections

3. Claim 3 is objected to because of the following informalities: --a-- should be inserted after “from” in line 2 for a proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case,

Claim 9: the claim language is confusing because, according to claim 1, the housing is a monolithic structure, according to claim 9, the main part and the cover part which are parts of the housing are sealed together by an ultrasonic weld.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2859

7. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 07027626 [hereinafter JP].

JP discloses in Fig. 1 a thermometer comprising a housing having an outer and an inner surfaces and is made of a unitary (monolithic) member made of a transparent material whose surface other than a window (viewing area) 20 is coated with an opaque member 13 (abstract). Thermometer also comprises a temperature sensor, a cover 7 and a display seen through the window (adjacent and substantially congruent).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP in view of Takagi 4729672 [hereinafter Takagi].

JP discloses in Fig. 1 a thermometer comprising a housing having an outer and an inner surfaces and is made of a unitary (monolithic) member made of a transparent material whose surface other than a window (viewing area) 20 is coated with an opaque member 13 (abstract). Thermometer also comprises a temperature sensor, a cover 7 and a display seen through the window (adjacent and substantially congruent). In a broad sense, JP's housing is made by an

Art Unit: 2859

injection molding because an injection molding is very well known method used to form a monolithical structure of a plastic material.

JP does not explicitly disclose the limitations of claims 4, 7 and 9.

Takagi discloses in Fig. 1 a device comprising a housing made of a main part and a cover (housing batteries) part attached to each other by an ultrasonic bonding (weld) and constituting, thus, a one piece structure. Takagi also discloses a metal probe cap 51 for protecting the temperature sensing unit.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the main part to the cover part of the housing disclosed by JP by an ultrasonic welding, as taught by Takagi, because an ultrasonic welding makes the housing watertight which will prevent the housing from contamination when disposed in a harsh environment.

It would have also been obvious to one of ordinary skill in the art at the time the invention was made to add a metal cap, as taught by Takagi, to the device disclosed by JP in order to protect the temperature sensing unit, as already suggested by Takagi.

10. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP and Takagi as applied to claims 4, 7 and 9 and further in view of Plimpton.

JP and Takagi disclose the device as stated above in paragraph 9.

They do not explicitly disclose an LCD stated in claim 5 and the limitations

Art Unit: 2859

of claim 6.

Plimpton discloses in Fig. 1 a device comprising an LCD and a housing which is being rugged in order to withstand bumps and jars (roughened) (col. 5, lines 6-7).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the display disclosed by JP with an LCD, as taught by Plimpton, because both of them are alternate types of displays used in the temperature art which will perform the same function of giving the user a visual information about the temperature measured, if one is replaced with the other.

It would have also been obvious to one of ordinary skill in the art at the time the invention was made to make the surface of the housing disclosed by JP rugged (roughen) so as it can withstand bumps and jars, as already suggested by Plimpton.

With respect to use of at least one of a mechanical or chemical treatment by exposure to abrading, etching or grinding, as stated in claim 6: the combination of JP and Takagi form their housing by an injection molding. Claim 6 is a "product by process" claim since the claim language is directed to the steps required to form the housing (at least one surface). Therefore, these steps have been given no patentable weight since it has been held that 1) the determination of patentability in "product by process" claim is based on the product itself, even though such claims are limited and defined by the process, and 2) the product in a "product by process" claim is unpatentable if it is the same as, or obvious from a product of the prior art, even if the prior art product was made by a different process. **In re Thorpe et al.** 227 USPQ 964 (Fed. Cir. 1985).

Art Unit: 2859

11. Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over JP.

JP discloses a device as stated above in paragraph 7.

JP does not disclose the particular material such as polycarbonate to make the main part and the cover part of the housing.

With respect to the particular material, i.e., polycarbonate, as stated in claim 10: JP makes the cover part and the main part of polystyrene. To make the cover part and the main part of the housing of polycarbonate, absent any criticality, is only considered to be the use of an “optimum” material that a person having ordinary skill in the art at the time the invention was made using routine experimentation would have found obvious to provide to make the main part and the cover of the thermometer used by JP since it has been held to be a matter of obvious design choice and within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of the invention. In re Leshin 125 USPQ 416.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP in view of Tseng.

JP discloses the device as stated above in paragraph 7.

JP does not disclose a switch as stated in claim 8.

Tseng discloses a device in the field of applicant's endeavor comprising a switch 34 to turn the device on/off.

Art Unit: 2859

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the switch, as taught by Tseng, to the housing of the device disclosed by JP, in order to turn the device on/off, as already suggested by Tseng..

Response to Arguments

13. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices.

15. Hvid et al. discloses a medical container made of a medical grade transparent plastic such as polycarbonate.

16. Any inquiry concerning this communication should be directed to the Examiner Verbitsky whose telephone number is (703) 306-5473.

Any inquiry of general nature should be directed to the Group Receptionist whose telephone number is (703) 308-0956.

GKV

April 23, 2001


Diego Gutierrez
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